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Levy

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/338,185 06/22/99 ZABLOCKI

J 99.423

020306 HM12/1031
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EXAMINER

CRANE, L

ART UNIT

PAPER NUMBER

1623

DATE MAILED:

10/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/338,185	Applicant(s) Zablocki et al.	
	Examiner L. E. Crane	Group Art Unit 1623	

- THE MAILING DATE of this communication appears on the cover sheet beneath the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **--3--** MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be filed after six months from the date of this communication.
- If the prior for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 USC §133).

Status

☒ Responsive to communication(s) filed on **-06/14/01 (amdt A) & 03/23/01 (IDS)-**.

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claims **--1-18, 20-24 & 26-28--** are pending in the application. Claims **-19 & 25-** have been cancelled. Of the above claims **--26 & 28--** are withdrawn from consideration.

☐ Claim(s) **--1--** is/are allowed.

☒ Claims **--1-18, 20-24 and 27--** are rejected.

☐ Claim(s) **--1--** is/are objected to.

☐ Claim(s) **--1--** are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on **-1-** is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on **-1-** is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119(a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) **-1-**.

☐ received in the national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: **-1-**.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). **--08--**

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other: **-1-**.

Art Unit 1623

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group 1600, Art Unit 1623.

5 Claims 19 and 25 have been cancelled, claims 1-18, 20 and 23-24 have been amended, and new claims 26-28 were added as per the amendments filed June 14, 2001. A supplementary Information Disclosure Statement (IDS) filed March 23, 2001 has been received with the cited reference and entered into the case.

10 Claims 1-18, 20-24 and 26-28 remain in the case.

Newly submitted claims 26 and 28 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- 15 i) claim 26 is directed to compounds not previously in the case and therefore not searched; and
- ii) in claim 28 the method of treatment is directed to subject matter not all of which was claimed in the originally submitted method of treatment claim and therefore not searched.

20 Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly claims 26 and 28 have been withdrawn from consideration as being directed to a non-elected invention. See 37 C.F.R. §1.142(b) and MPEP §821.03.

25 Claims 1-18, 20-24 and 27 remain in the case.

Art Unit 1623

The disclosure is objected to because of the following informalities:

5 The newly added names of compounds using "adenosine" as the root name identified in the Examples numbered 1-6 are inconsistent with the name previously provided by including an N⁶-tetrahydrofuranyl substituent not previously named. Examiner assumes in this Office action that the noted incompatible subject matter is a typographical error.

Appropriate correction is required.

10 Claims 1-18, 20-24 and 27 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

15 Claim 1 is directed broadly to a vast array of compounds with multiple substituents nested on substituents only a small fraction of which have been synthesized or shown by applicant to have pharmacological activity.

Applicant's arguments filed June 14, 2001 have been fully considered but they are not persuasive.

20 Applicant argues that the instant claimed subject matter is adequately enabled by disclosure of the synthesis at Scheme 1 and that "it would be readily apparent to one of skill in the art how to select and synthesize the wide variety of compounds that are encompassed by the claimed invention." Examiner respectfully disagrees. Applicant's
25 argument is nothing more than a bald assertion which, like the instant

Art Unit 1623

claims, lacks enabling support in the form of specific description within the instant disclosure where the actual guidance necessary to make the huge variety of nested-variable-defined-substituent adenosine derivatives without undue experimentation should be found, but is
5 absent. For this reason the instant grounds of rejection has been maintained.

Claims 1 and 23 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the
10 invention.

In claim 1 at lines 29, 43, 63 and 69, the prefix "lkyl" appears to be a misspelling of -- alkyl --. Clarification is respectfully requested.

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new grounds of rejection.

15 Claim 23 is incorrect and lacks proper antecedent basis for failure to have proper terminal punctuation and because it refers to "the composition of claim 1" instead of
-- a compound of claim 1 --.

20 Applicant's arguments with respect to claim 23 have been considered but are moot in view of the new grounds of rejection.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

25 A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a

Art Unit 1623


first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the Papers related to this application may be submitted to Group 1600 via facsimile transmission(FAX). The transmission of such papers must conform with the notice published in the Official Gazette (1096 OG 30, November 15, 1989). The telephone numbers for the FAX machines operated by Group 1600 are (703) 308-4556 and 703-305-3592.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner L. E. Crane whose telephone number is 703-308-4639. The examiner can normally be reached between 9:30 AM and 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Gary Geist, can be reached at (703)-308-1701.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is 703-308-1235.

LECrane:lec
10/26/01


RALPH GITOMER
PRIMARY EXAMINER
GROUP 1200